

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board
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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
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11 *Ex parte* DIRK OOMS and WIM LIVENS
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14 Appeal 2007-1116
15 Application 09/422,347¹
16 Technology Center 2600
17

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19 Decided: April 25, 2007
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22 *Before:* ANITA PELLMAN GROSS, STUART S. LEVY, and
23 ROBERT E. NAPPI, *Administrative Patent Judges.*
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25 LEVY, *Administrative Patent Judge.*
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28 DECISION ON APPEAL
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30 STATEMENT OF CASE

31 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
32 of claims 1-7, 9, and 11-20.² We have jurisdiction under 35 U.S.C. § 6(b)
33 (2002).

¹ Application filed October 21, 1999. The real party in interest is the assignee, Alcatel.

1 Appellants invented a device and method to compress destination
2 addresses of a multicast message. (Specification 1).

3 Claims 1 and 19 are representative of the invention and read as
4 follows:

5 1. A device for compressing a list of final destination
6 addresses for a multicast message, wherein each final
7 destination address in said list represents a different final
8 destination host, said device comprising:
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10 a detector that detects a common prefix in at least two
11 different final destination addresses from said list of final
12 destination addresses,

13 a generator that generates a suffix list for final destination
14 addresses from said list of final destination addresses that are
15 detected to have a common prefix, wherein said suffix list
16 represents the non-identical portions of said final destination
17 addresses detected to have a common prefix, and
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19 an adder that adds said suffix list to said common prefix
20 to create a compound destination address consisting of
21 compressed final destination addresses.
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23 19. A communications network comprising:
24

25 a host that generates multicast packets, wherein said host
26 comprises a device for compressing a list of final destination
27 addresses according to claim 1; and
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² An amendment filed on October 28, 2005 under the provisions of 37 C.F.R § 1.116 was refused entry by the Examiner (Br. 5).

a router connected to said host, wherein said router receives a compound destination address created by said host and derives the common prefixes from said compound destination address to determine the next hop for each common prefix.

The Examiner rejected claims 1-7, 9, and 11-20 under 35 U.S.C.

§ 103(a) (2004) as being unpatentable over Boivie.

The prior art relied upon by the Examiner in rejecting the claims on

appeal is:

US 6,502,140 B1

Dec. 31, 2002

(Jan. 29, 1999)

We note at the outset that Appellants present specific arguments with

respect to claims 1, 2, and 7. We begin with independent claims 1 and 7.

Appellants contend that Boivie does not seek to shorten the header, but

rather puts more information into the header in order to ease the burden on

the routers. (Br. 11). Appellants assert that each of nodes R2, C, and F are

not final destination nodes, but instead are routers along the way. (Br. 12).

Appellants contend that Boivie's folding method uses a successive factoring

process to compress routing information, but not to compress the destination

addresses. (Br. 13). In addition, Appellants note that each of claims 1 and 7

recites "that the destination address consists of final destination addresses,

whereas Boivie includes not only the final destination addresses, but also the

address of intermediate nodes." (Br. 13).

The Examiner contends (Answer³ 5) that "[t]he only difference

between the claims and Boivie lies in the type of addressing used, in the

³ Supp. Answer mailed October 25, 2006 (hereinafter: Answer).

1 claims the final destination addresses do not include references to the
2 intermediate node, while Boivie does." In the Examiner's opinion, it would
3 have been obvious to apply the compression technique of Boivie with any
4 addressing scheme because it would have the same benefit, reduction of
5 traffic.

6 We reverse and add a New Ground of Rejection under 37 C.F.R.
7 § 41.50(b).

8 **ISSUE**

9 Have Appellants shown that the Examiner erred in holding that Boivie
10 renders obvious the language of claims 1-7, 9, and 11-20. With respect to
11 independent claims 1 and 7, and the claims dependent therefrom, the issue
12 turns on whether Boivie suggests that the compound destination address
13 consists of compressed final destination addresses. With regard to claims 19
14 and 20 the issue is whether Boivie would have suggested to an artisan the
15 language of these claims.

16
17 **FINDINGS OF FACT**

18 We determine that the following enumerated findings are supported
19 by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849
20 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the
21 general evidentiary standard for proceedings before the Office).

22 1. Appellants invented a device and method to compress destination
23 addresses of a multicast message. (Specification 1).

24 2. The main advantages of connectionless multicasting are that no
25 multicast allocation is required and routers do not have to maintain a

1 state per session. Connectionless multicasting however requires each
2 packet to contain all remaining destinations. (Specification 2 & 3).
3 3. A common prefix based compression method for IP destination
4 addresses is known. (*Id.*).
5 4. An object of the invention is to significantly reduce the overhead
6 of multicasted packets in any connectionless multicast session
7 wherein at least two destination addresses have a common prefix.
8 (*Id.*).
9 5. The invention can be applied iteratively so that first, a list of IP
10 addresses with a rather large common prefix is compressed into a
11 compound address. The compound address can then be further
12 combined with other compound addresses or IP destination addresses
13 that all have a shorter common prefix to generate a new compound
14 address in a next compression iteration. (Specification 4-5).
15 6. Host H1 and the three routers R1-R3 incorporate a destination list
16 compression device. (Specification 5).
17 7. Boivie relates to multicasting under various protocols, including
18 the Internet protocol (IP). (col. 1, ll. 13-15).
19 8. The system can handle a very large number of small groups
20 because the nodes in the network do not need to disseminate or store
21 any multicast routing information for these groups. (Boivie, col. 2, ll.
22 19-22).
23 9. In accordance with the invention of Boivie, the source of a
24 multicast transmission sends multicast packets, each comprising a
25 payload and multicast route information, for use by intermediate

nodes to route each packet to the desired destinations, replicating the packets as necessary. (col. 2, ll. 36-40).

3 10. At the beginning of a multicast transmission, node A determines
4 the route to each of the destinations. Once node A has a route to each
5 of the destinations, it can fold the routes together into a multicast tree.
6 This folding can be accomplished in two steps. In step 1, routes that
7 share a common prefix are grouped together. For example, if node A
8 had the following routes to destinations B, C, and D: R1R2D, R1B,
9 R1R2C, it would sort the routes to produce the following sorted lists:
0 R1B, R1R2C, R1R2D. In step 2, node A factors out the common
1 parts of adjacent list elements to produce a single route corresponding
2 to a multicast distribution. The above routes can be combined to
3 produce the following list: R1B, R1R2(C D). Then the remaining two
4 routes can be combined to produce a list with a single element. R1 (B
5 R2(C D)). (col. 4, ll. 30-57).

6 11. The above folded routes include intermediate router (e.g. R1, R2)
7 information and do not consist of final destination addresses.

PRINCIPLES OF LAW

To determine whether a prima facie case of obviousness has been established, we are guided by the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art.

1 In addition to our review of the *Graham* factors, we also consider whether a
2 person of ordinary skill in the art, possessed with the understandings and
3 knowledge reflected in the prior art, and motivated by the general problem
4 facing the inventor, would have been led to make the combination recited in
5 the claims. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, The Federal
6 Circuit states that "[the] mere fact that the prior art may be modified in the
7 manner suggested by the Examiner does not make the modification obvious
8 unless the prior art suggested the desirability of the modification." *In re*
9 *Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir.
10 1992), citing *In re Gordon*, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.
11 Cir. 1984).

12 "Obviousness may not be established using hindsight or in view of the
13 teachings or suggestions of the inventor." *Para-Ordnance Mfg. V. SGS*
14 *Importers Int'l*, 73 F.3d 1087, 37 USPQ 2d at 1239 (Fed. Cir. 1995), citing
15 *W. L. Gore & Assocs., v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ
16 at 311, 312-13 (Fed. Cir. 1983).

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ANALYSIS

20 Although we find from fact 10 that Boivie's folding of routes groups
21 together routes with common prefixes, and includes a single route having
22 common suffixes, we find, from fact 11 that in Boivie, the compound
23 address includes the intermediate routers, as argued by Appellants, and does
24 not consist of compressed final destination addresses, as required by
25 independent claims 1 and 7. With respect to the Examiner's assertion
26 (Answer 5) that "[i]t would have been obvious ... to apply the compression

1 technique of Boivie with any addressing scheme because it would have the
2 same benefit, reduction of traffic," we consider the Examiner's assertion to
3 be that the system of Boivie could be used with an addressing scheme that
4 does not include intermediate routers, or with Appellants' addressing
5 scheme. However, we find no teaching or suggestion of making these
6 modifications based upon the description of Boivie, and we find the
7 Examiner's position to be based upon hindsight. In addition, we find that the
8 Examiner's assertion does not address the claim language of the compound
9 destination address *consisting of* compressed final destination addresses.
10 From the above language of the claims, we find that the claims preclude the
11 compressed final destination addresses from including the intermediate
12 routers of Boivie.

13 We are not persuaded by the Examiner's assertion (Answer 7) that
14 "appealed claim 1 is directed to compressing a list of addresses and does not
15 directly claim compression of the addresses themselves." (Emphasis
16 original.) Firstly, claim 1 is directed to compressing a list of final
17 destination addresses, not just destination addresses. Secondly, from the
18 language in the claim of detecting common prefixes, generating a suffix list
19 for final destination addresses, and adding the suffix list to the common
20 prefix, we find that the claim does recite compression of the addresses
21 themselves. From all of the above, we find that the teachings and
22 suggestions of Boivie would not have suggested the language of independent
23 claims 1 and 7, or claims 2-6 and 9-18, which depend therefrom.

1 We turn next to independent claim 19. We note at the outset that
2 Appellants have not provided any specific arguments with respect to this
3 claim in either the Brief or the Reply Brief. In addition, it is unclear from
4 the language of the claim whether claim 19 is an independent claim or a
5 dependent claim, for the reasons which follow. Claim 19 recites, *inter alia*,
6 that "wherein said host comprises a device for compressing a list of final
7 destination addresses according to claim 1." It is not clear from this
8 language whether claim 19 is a dependent claim because it refers back to an
9 earlier claim, in which case it would include all of the limitations of claim 1,
10 or whether claim 19 is an independent claim that refers back to independent
11 claim 1 for the device for compressing a list of final destination addresses.
12 The only time claim 1 recites "a device for compressing a list of final
13 destination addresses" appears in the preamble of the claim. This would
14 imply that the device of claim 1 is included in claim 19. However, from our
15 review of claim 19 and dependent claim 20 we find that claim 19 does not
16 recite creating a compound destination address consisting of compressed
17 final destination addresses. However, claim 20 recites, *inter alia*, that the
18 adder acts to "create a new compound destination address consisting of
19 compressed final destination addresses." Under the Doctrine of Claim
20 Differentiation, since the consisting language appears in dependent claim 20,
21 we find that it is not included in independent claim 19. Thus, it appears that
22 claim 19 is an independent claim that refers to another independent claim.

1 Under 37 C.F.R. § 1.75, a claim that refers to an earlier claim is a dependent
2 claim. That dependent claim shall be construed to include all of the
3 limitations of the claim from which it depends. Under 35 U.S.C. § 112(4) a
4 claim in dependent form shall contain a reference to a claim previously set
5 forth and then specify a further limitation Because claim 19 does not
6 appear to include all of the limitations of claim 1, the metes and bounds of
7 claim 19, and claim 20, which depends therefrom, cannot be readily
8 ascertained. It follows that we must reverse, *pro forma*, the rejection of
9 claims 19 and 20, because we find the claims to be indefinite.

10 New Ground of Rejection under the provisions of 37 C.F.R. § 41.50(b).

11 Claims 19 and 20 are rejected under 35 U.S.C. § 112 (second
12 paragraph) as being indefinite for the reasons enumerated, *supra*.

13 In comparing the claimed subject matter with the applied prior art, it is
14 apparent to us that considerable speculations and assumptions are necessary
15 in order to determine what in fact is being claimed. Since a rejection based
16 on prior art cannot be based on speculations and assumptions, *see In re*
17 *Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we enter this
18 new ground of rejection of claims 19 and 20. Note that because we find
19 claims 19 and 20 to be indefinite, we do not address the merits of the
20 rejection of these claims.

21
22 CONCLUSION OF LAW

23 On the record before us, Appellants have shown that the Examiner has
24 erred in holding that the teachings and suggestions of Boivie would have
25 suggested the language of claims 1-7 and 9-18. In addition, we reverse the

1 rejection of claims 19 and 20 because we find these claims to be indefinite,
2 and enter a new ground of rejection of claims 19 and 20 under 35 U.S.C.
3 § 112 (second paragraph).

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DECISION

6 The Examiner's rejection of claims 1-7 and 9-20 is reversed. In
7 addition, we add a New Ground of Rejection of claims 19 and 20 (as being
8 indefinite) under the provisions of 37 C.F.R. § 41.50(b).

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10 REVERSED; 37 C.F.R. § 41.50(b)

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